

REMARKS

In the first Office Action dated February 4, 2003, all pending claims 1 and 45-63 are rejected. The Examiner rejects claims 1 and 45-57 under 35 U.S.C. 101 as double patenting in light of the subject matter as claimed in priority reference U.S. Patent No. 6,168,242 as follows: current claims 1 and 45-47 as identical to the subject matter of '242 patent claims 1-9; current claims 48-51 as identical to the subject matter of '242 patent claims 10-24; and current claims 52-57 as identical to subject matter of '242 patent claims 25-38.

The Examiner further rejects current claims 1, 45-56, and 58-63 under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 5,589,280 (the Gibbons patent).

Applicant respectfully traverses all rejections as explained below.

Statutory Double Patent Rejection under 35 U.S.C. 101:

The Examiner rejects claims 1 and 45-47 as statutory double patenting in view of claims 1-9 of the '242 patent. In order for a statutory double patenting rejection under 35 U.S.C. 101 to be appropriate, the "same invention" must be claimed twice.

The commonly relied-upon test to determine if the "same invention" is claimed is whether a claim in the application could be literally infringed without literally infringing the corresponding claim in the patent. If so, identical subject matter is not defined by both claims and statutory double patenting would not exist. This test is clearly illustrated when the claims differ from each other (aside from minor differences in language, punctuation, etc.), regardless of

whether the difference is obvious, so as not to be considered to be drawn to the same invention for double patenting purposes under 35 U.S.C. 101.

Current claims 1 and 45-47 clearly meet both standards identified above so as to make a statutory double patenting rejection improper. Current claim 1 is clearly not the “same” as the ‘242 patent claim 1 in that current claim 1 is directed to a coating while the ‘242 patent claim 1 is directed to an article. Further, current claim 1 is much broader in scope than the ‘242 patent claim 1. For example, current claim 1 does not limit the second layer to a “color layer.” Further, current claim 1 does not call for the final protectant polymeric layer. Therefore, current claim 1 could clearly be infringed by an object that would not infringe the ‘242 patent claim 1.

Thus, by definition, current claim 1 and the ‘242 patent claim 1 are not coextensive in scope and therefore the “same invention” is not claimed twice. Further, the broad and distinct differences of current claim 1 carry over to its dependent claims so that claims 45-47 likewise do not define the “same invention” as the ‘242 patent claims 2-9.

The arguments regarding the improper statutory double patenting rejection of current claims 1 and 45-47 are fully applicable to the statutory double patenting rejection of current claims 48-51 based upon the ‘242 patent claims 10-24 as well as the double patenting rejection of current claims 52-57 based upon the ‘242 patent claims 25-38. Therefore, Applicant respectfully requests that the Examiner withdraw all statutory double patenting rejections of claims 1 and 45-57.

To address any potential issues regarding non-statutory double patenting and the potential problems addressed by 37 C.F.R. 1.321(c)(3), Applicant is willing to execute and file a terminal disclaimer. The Examiner's approval is respectfully requested.

Rejection based on 35 U.S.C. 102(e):

Claims 1, 45-56, and 58-63 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,589,280 (hereinafter "the Gibbons patent"). This rejection is respectfully traversed.

The Gibbons patent is directed to the process for producing a high-adhesion metal-on-plastic product (col. 4, lines 43-45). To provide such a coating, a plastic product is coated with a first adhesion-promoting metal layer made up of one or more metals characterized by having an oxide heat of formation of less than -50,000 calories/gm atom of metal. A thick, functional metal layer made up of one or more functional metals having an oxide heat of formation greater than -40,000 calories/gm atom of metal is then applied to the adhesion-promoting layer.

In contrast with the Gibbons patent, the present claims require a first polymeric layer on the surface of the article followed by a second layer comprising a compound selected from the group consisting of zirconium compound, titanium compound or zirconium/titanium alloy compound. In attempting to meet Applicant's first polymeric layer limitation, the Examiner points to the paragraph bridging columns 4 and 5. However, this portion of the Gibbons specification identifies the plastic composition of the product and not the first coating layer. The

first coating layer in Gibbons is an adhesion-promoting, metal layer that improves adhesion between the plastic article and the thick, functional, metal layer.

Therefore, as the claims in the priority-based '242 patent were distinguishable over the Gibbons patent, Applicant's claims likewise appear distinguishable over the Gibbons patent. Thus, Applicant respectfully requests that the 102(e) rejection be withdrawn. In light of the foregoing, Applicant respectfully submits that the application is now in condition for allowance.

Respectfully submitted,



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